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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/785,978	02/26/2004	Masatoshi Sugimasa	1021.43550X00	2672

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EXAMINER

RABAGO, ROBERTO

ART UNIT	PAPER NUMBER
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1713

DATE MAILED: 06/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/785,978

Applicant(s)

SUGIMASA ET AL.

Examiner

Roberto Rábago

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— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) 3-8, 10 and 11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2 and 9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2/26/04
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Group I, claims 1 and 2, with election of species in the reply filed on 3/13/2006 is acknowledged. The traversal is on the ground(s) that the species are not related as mutually exclusive species in an intermediate-final product relationship. This is not found persuasive for the following reasons. The addition of a second polymer as blend component results in a transformation of the originally recited composition of claim 1 to a new composition wherein the distinct identity of the originally stated composition is lost. A polymer blend would necessarily have the properties which result from the molecular interactions between the two polymers, and this is the basis for stating that the species are related as mutually exclusive species in an intermediate-final product relationship. Applicants are in effect arguing that because claim 1 is open-ended, then the scope includes all embodiments which include additional components, even those which result in transformation of the originally stated materials to materials of wholly different properties. A hypothetical example of the instant situation would be as follows:

Claim 1: A composition comprising chemical A.

Claim 2: A composition comprising the reaction product of the composition of claim 1 with chemical B, resulting in a composition comprising chemical C.

In this hypothetical example, these claims are unambiguously related as intermediate-final product. Analogously, applicants' first composition (as stated in claim

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1) is an intermediate, and the blend composition (as stated in claims 3 and 4) is the final product. The two blended polymers would form a composition which has a different set of properties than either of the initial components, and are therefore properly separated as intermediate-final products.

The requirement is still deemed proper and is therefore made FINAL. New claim 9 is joined with claims 1 and 2 for examination. New claims 10 and 11 are joined with withdrawn claims 5-8.

Following a search of the elected species (i.e., Example 2), the remaining species are joined for examination.

Information Disclosure Statement

2. Applicants are advised that the JP documents cited on the IDS filed 2/26/2004 have been considered solely on the basis of the English language abstract as provided by applicants.

Claim Objections

3. Claim 1 is objected to because it ends with a semicolon instead of a period.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 2 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Amou et al. (US 20020161091).

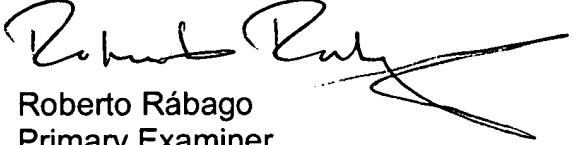
Examples 1-5 disclose compositions comprising cyclic polyolefin, BVPE and the catalyst of claim 9. Missing from the examples is an embodiment wherein the rubber component comprises styrene. However, the reference has expressly recommended including styrene as a rubbery copolymer component for the purpose of improving the heat resistance of the product [0054]. The process is also disclosed in reference claims 1-4. Therefore, one of ordinary skill in the art would immediately envisage including in the composition a rubber which includes styrene in a composition analogous to those shown in the reference examples.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Roberto Rábago whose telephone number is (571) 272-1109. The examiner can normally be reached on Monday - Friday from 8:00 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Roberto Rábago
Primary Examiner
Art Unit 1713

RR
May 30, 2006